



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,941	01/15/2002	William Kress Bodin	AUS920010464US1	4426
34533 7590 05/02/2007 INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469			EXAMINER LY, ANH	
			ART UNIT 2162	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/046,941

Applicant(s)

BODIN ET AL.

Examiner

Anh Ly

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,8,11,14 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 6-7, 9-10, 12-13, 15-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is response to Applicants' AMENDMENT filed on 04/10/2007.
2. Claims 2, 5, 8, 11, 14 and 17 have been cancelled.
3. Claims 1, 3-4, 6-7, 9-10, 12-13, 15-16 and 18 are pending in this Application.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 13 is rejected under 35 U.S.C. 101 because: claim 13 is "computer software product", (a "computer program product", which is as a "computer-executable program" stored on a computer-readable medium such as CD without executing directly or positively by a physical object or machine or computer system) software per se. (lacking or missing a physical object or machine to implement or execute the computer readable codes or instructions stored on the media). A computer/machine executable program is a non-functional descriptive material. It is **descriptive material per se**. The descriptive material includes non-functional and functional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer- readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical

Art Unit: 2162

application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. (MPEP 2106.01 [R-5] - Computer-Related Nonstatutory Subject matter).

Claimed Subject Matter Not in Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “context”, “shortcut” and “a recording medium” do not specify clearly, defined well or fully support in the instant specification. They let the examiner does not understand well the claimed invention: A shortcut is either creating icon shortcut for a web page or web site or a combination of a sequence of keystroke; a

Art Unit: 2162

context may be a icon, a window screen or a window application or a search string and what type of medium or carrying signal receiver. Applicants are advised to amend the claims in a language that helps one of ordinary skills in the art to understand the intent of use and steps of invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-4, 6-7, 9-10, 12-13, 15-16 and 18, as the best understanding of examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No.: 5,787,234 issued to Molly.

With respect to claim 1, Molly teaches a context aware, shortcut enabled method of presenting information through a user interface on a client device (solving problem from help desk to clients or users having problems by using the case window for TOP OF MIND software. The window screen (context aware) is receiving the input from user/client via user interface and presenting the result (matching the query condition or criteria) based on the entered query or request (shortcut: entering queries on the window screen: entries) from the user or client: see fig. 3 and col. 6, lines 38-65), the method comprising the steps of:

selecting a context, wherein the context has an initial context value (the window screen having initializing value with "PROBLEM");

receiving a shortcut entered through the user interface, the shortcut having associated with it a shortcut field name set comprising one or more shortcut field names (user selects (as entering entry) the type of object having problem and its type, model problems in order to let help desk to solve or give the solution to fix it: figs. 3-6; col. 7, lines 32-52);

inferring from a context definition table, in dependence upon the context, a context table name and a context field name (the window screen has some definition fields for entries: col. 6, lines 58-67 and col. 7, lines 1-30);

selecting information records from an information database in dependence upon the context, the context table name, the shortcut field names, and the context field name, the selecting further comprising creating a query, the query including the context table name as a table for the query, the shortcut field names as field names for the query, and the context and the context field name in a condition for the query (user or client selects the problem, diagnosis, action... via a picklist (item 57) of each of field name displayed in the left window screen: a dialog pull down menu: see figs. 3-6, col. 7, lines 54-67 and col. 8, lines 1-67 and col. 9. lines 1-58);

displaying selected records through the user interface on the client device (displaying the result from the entered entries from user: figs 7 and 9-10: col. 9, lines 22-67 and col. 10, lines 1-35);

assigning, in response to user input through the user interface, a new context value to the context (user is able to enter or select new type of problem via a picklist: figs. 3-6); and

repeating, in response to user input from the user interface, the steps of assigning a new context value to the context, inferring a context table name and a context field name, selecting records, and downloading selected records (the window screen is used for any problems in the picklist for each type of problem defined on the field name of component: figs. 3-6).

With respect to claim 3, Molly teaches wherein selecting a context further comprises selecting a default context (the default value here in this window screen is "PROBLEM": case type: figs. 3-6).

With respect to claim 4, Molly teaches wherein selecting a context further comprises receiving a context from the client device, the context entered by a user through the user interface (user or client able to select or enter entry via user interface with pulldown menu dialog box: figs. 3-6).

With respect to claim 6, Molly teaches further comprising selecting a display form in dependence upon the shortcut value, wherein displaying selected records through the user interface on the client device further comprises downloading the selected records to the client device for display in the display form (the result from the query or request from user to be displayed directly on the client or user computer device: figs. 9-10: col. 9, lines 58-67 and col. 10, lines 1-35).

Claim 7 is essentially the same as claim 1 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 9 is essentially the same as claim 3 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 10 is essentially the same as claim 4 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove. Claim 12 is essentially the same as claim 6 except that it is directed to a system rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.

Claim 13 is essentially the same as claim 1 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 15 is essentially the same as claim 3 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 3 hereinabove.

Claim 16 is essentially the same as claim 4 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 18 is essentially the same as claim 6 except that it is directed to a computer program product rather than a method, and is rejected for the same reason as applied to the claim 6 hereinabove.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV (**written authorization being given by Applicant(s) - MPEP 502.03 [R-2]**) or fax to (571) 273-4039 (examiner's personal fax number).

The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene**, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY 
APR. 17th, 2007



JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100